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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,539	08/23/2001	Marko Schuba	52275-00009USPX	1522
7590 01/27/2006 Spencer C. Patterson, Esq. Jenkins and Gilchrist, P.C. 3200 Fountain Place 1445 Ross Ave. Dallas, TX 75202			EXAMINER OYEBISI, OJO O	
			ART UNIT 3628	PAPER NUMBER

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,539

Applicant(s)

SCHUBA ET AL.

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/23/01.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by LeBourgeois (Le hereinafter, US PAT: 6,026,166).

Re claim 1. Le discloses a method for initiating an electronic payment transaction comprising the following steps: receiving a payment request by a filter of a communication system (i.e., user system requests PIN from user, fig 3A element 326) , modifying the payment request by adding a transaction identification to produce a modified payment request (i.e., user system generates real time signature in dependence upon challenge code, PIN for first user identity, and **data regarding listed components**....., see fig 3B, element 330) transmitting the modified payment request to a transaction server (i.e., the user system transmits the real time digital signature to the merchant system which further transmits it on to the **certification server**, see col.7 lines 33-35, also see fig.3B elements 332 and 334)transmitting a payment request information signal containing the transaction identification from the filter to a communication

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terminal (i.e., merchant system see fig.3B elements 332), transmitting a payment initiation containing an additional transaction identification from the communication terminal to the transaction server (i.e., the merchant system transmits payment information, real time signature, and challenge code to certification server, see fig.3B elements 334), comparing the transaction identifications of the modified payment request and the payment initiation by the transaction server (i.e., the certification server determines if the challenge code+the original signature matches the real time digital signature provided by the user system, see col.7 lines 36-44) performing the payment transaction by the transaction server if the transaction identifications correspond with each other (see col.7 lines 44-50, also see fig 3B elements 340, 338, 342, 344, and 346)

Re claim 2. Le further discloses the method, wherein the transaction identification is a random number (i.e., the challenge code is generated randomly, see col.7 lines 5-8).

Re claim 3. Le further discloses the method, wherein the payment request is destined for the communication terminal (i.e., merchant system) and including the step of the filter recognizing the payment request using a first identifier (i.e., first signature/original signature, see abstract) and intercepting the payment request (i.e., the merchant system generates a challenge code and transmits it to the user system, the challenge code serves as an inquiry to the user system to provide information so that the merchant system can verify the identity of the user, see col.7, lines 1-7).

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Re claims 4 and 5. Le further discloses the method, wherein the filter receives and stores a filter initiation message containing an address of a transaction server, and wherein the filter sends the modified payment request by means of the stored address (i.e., since there is communication between the filter (user system) and the transaction server (certification server), it is inherent that the filter has the IP/MAC address of the device that the filter communicates with).

Re claim 6. Le further discloses the Method, wherein the transaction server sends the filter initiation message upon receipt of a filter initiation request (i.e., certification server receives payment information, see fig 3b element 334, and certification server transmits certification result to merchant system, which in turn notifies the user system see fig.3b elements 344 and 346).

Re claim 7. Le further discloses the method for initiating a filter of a communication terminal, wherein a transaction server receives a filter initiation request (see fig.3b element 336), including steps of: the transaction server sends a filter initiation message containing an address identifying the transaction server, and wherein the filter receives the filter initiation message and stores the address (i.e., since there is communication between the filter (user system) and the transaction server (certification server), it is inherent that the filter has the IP/MAC address of the device that the filter communicates with).

Re claim 8. Claim 8 recites similar limitations to claim 3, and thus rejected using the same art and rationale in the rejection of claim 3.

Re claim 9. Claim 9 recites similar limitations to claim 1, and thus rejected using the same art and rationale in the rejection of claim 1.

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Re claim 10. Le further discloses the Filter further comprising a random sequence generator determining a random number as the transaction identification (i.e., the challenge code is randomly generated, see col.7 lines 5-7).

Re claim 11. Claim 11 recites similar limitations to claim 3, and thus rejected using the same art and rationale in the rejection of claim 3.

Re claims 12 and 13. Claims 12 and 13 recites similar limitations to claim 4 and 5 above and thus rejected using the same art and rationale in the rejection of claims 4 and 5.

Re claim 14. Le discloses a Transaction server, comprising an input interface for receiving a modified payment request containing a first transaction identification (i.e., first or original signature, see abstract) and for receiving a payment initiation containing a second transaction identification (i.e., second or real time signature provided by the user system, see abstract), a computer unit for comparing the transaction identifications of the modified payment request and the payment initiation (i.e., the certification server determines if the challenge code+the original signature matches the real time digital signature provided by the user system, see col.7 lines 36-44), and an output interface, via which the computer unit performs a payment transaction if the transaction identifications correspond with each other (see col.7 lines 44-50, also see fig 3B elements 340, 338, 342, 344, and 346)

Re claim 15. Claim 15 recites similar limitations to claim 6, and thus rejected using the same art and rationale in the rejection of claim 6.

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Re claim 16. Claim 16 recites similar limitations to claim 1, and thus rejected using the same art and rationale in the rejection of claim 1.

Re claim 17. Le further discloses Computer program, wherein the computer program is stored on a computer-readable medium (see fig.2 element 204 and 210).

The prior art of record, Bartoli et al (US PAT: 6,047,268), cited but not relied upon is pertinent to the present application. Bartoli discloses a method and apparatus for authenticating transactions accomplished over a data network utilizes a "cookie" containing both static information (user-identifying information) and dynamic information (transaction-based information). The transaction-oriented dynamic information portion comprises a random number and a sequence number, the latter tracking the number of billing transactions conducted by the user associated with the account number. A billing server, upon receiving the cookie containing the static and dynamic information portions, identifies the user. The expected dynamic information is compared to the received dynamic information, and if the two information match, the user is authenticated to proceed with the current transaction (see abstract).


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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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